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### REMARKS

Claims 1, 2 and 5 through 22 are pending in the application.

Applicants acknowledge with gratitude the Examiner's indication that Claims 1, 2 and 5 through 17 are patentable in light of the art of record.

Claim 1 has been amended to replace the term "composition" with the term "constituent." Support for this amendment can be found in the Application-as-filed, for example on Page 4, 2<sup>nd</sup> full paragraph in its entirety (noting thermoplastic as a constituent).

Claims 18 and 22 have been canceled solely to advance prosecution of the case and without prejudice or disclaimer to the filing of continuing applications thereon.

Claims 19 and 20 have been amended to reflect that advantageous inventive films are formed from a single thermoplastic consisting of at least one of either polyethylene terephthalate or polybutylene terephthalate. Support for this amendment can be found in the Application-as-filed, for example on Page 4, 2<sup>nd</sup> and 3<sup>rd</sup> full paragraphs in their entirety ([i] noting thermoplastic as a constituent; [ii] listing polyethylene terephthalate and polybutylene terephthalate as exemplary alternate thermoplastics and [iii] defining "thermoplastic" as including mixtures).

Applicants respectfully submit that this response does not raise new issues, but merely places the above-referenced application either in condition for allowance, or alternatively, in better form for appeal. Reexamination and reconsideration of this application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the remarks which follow.

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Written Description

Claims 1, 2 and 5 through 17 stand rejected over the recitation "a single thermoplastic composition."

Applicants respectfully submit that sufficient support exists within the Application-as-filed for "a single thermoplastic composition" Applicants respectfully submit that there is no requirement under United States practice of "in ipsis verbis." The Application-as-filed clearly conveys to one skilled in the art that Applicants invented the claimed subject matter; i.e. film formed from thermoplastic consisting entirely of polyethylene terephthalate, polybutylene terephthalate or mixtures thereof. The Examiner's attention is kindly directed to the Application-as-filed, on Page 4, 2<sup>nd</sup> and 3<sup>rd</sup> full paragraphs in their entirety (listing polyethylene terephthalate and polybutylene terephthalate as exemplary alternate thermoplastics and further defining "thermoplastic" as including mixtures), as well as Page 6, 2<sup>nd</sup> full paragraph (noting inventive "polyethylene terephthalate" film); Page 8, 5<sup>th</sup> paragraph, second sentence (noting "polyethylene terephthalate" as thermoplastic) and Pages 13 through 17 (Examples 1 through 3, employing polyethylene terephthalate). Consequently, the Examiner has failed to provide a prima facie case of failure of written description.

Nevertheless, without further addressing the merits of the rejection and solely to advance prosecution of the case, Claim 1 has been amended to recite "constituent" in lieu of "composition." Support for this amendment can be found in the Application-as-filed, for example on Page 4, 2<sup>nd</sup> full paragraph, first sentence.

Accordingly, Applicants respectfully request withdrawal of this rejection.

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Claims 19 - 21 as- Amended are  
Patentable in Light of the Art of Record

Claims 19 through 21 stand rejected over United States Patent No. 5, 955, 181 to Peiffer et al. (US 181) in view of United States Patent No. 5,936,048 to Oishi et al. (US 048) and United States Patent No. 5,804,626 to Rogers et al. (US 626).

Claims 19 and 20 have been amended to exclude unrecited polymer components from the films as a whole, as kindly intimated by the Examiner. Claims 19 and 20 have more particularly been amended to reflect that advantageous inventive films are formed from a single thermoplastic constituent consisting of at least one of either polyethylene terephthalate or polybutylene terephthalate.

Applicants respectfully submit that the cited references do not teach or suggest Claims 19 through 21 as-amended.

US 181 discloses the incorporation of ethylene 2,6-naphthalate ("EN") into the heat-seal layer of packaging films to improve the sticking properties of the resulting films. (Col. 3, lines 29 – 32 and lines 45 – 50 and Col. 5, lines 11 - 13). US 181 thus requires EN within its films. (Col. 5, lines 10 – 17).

US 048 is directed to flame retardant norbornenyl-modified polymers. (Col. 4, lines 40 – 45; Col. 7, lines 60 – 66 and Col. 9, line 66 – Col. 10, line 3 and Col. 9, lines 37 - 49).

US 626 is directed to polyethylene naphthalate compositions having improved hydrolytic stability that are used to form monofilament. (Col. 2, lines 53 – 56).

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Applicants respectfully submit that to modify any or all of US 181, US 626 or US 048 so as to avoid either the polyethylene naphthalate or norbornenyl-modified polymer (respectively) would clearly render the resulting article unfit for its intended purpose. MPEP 2143.01 (citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)).

Applicants further respectfully reiterate that there would have been no motivation to have combined these references, which are from altogether different fields of endeavor and address altogether different problems.

However, even if combined (which Applicants submit should not be done), the inventive films formed from a single thermoplastic constituent consisting of at least one of either polyethylene terephthalate or polybutylene terephthalate would not have resulted.

Accordingly, Applicants respectfully submit that Claims 19 through 21 as-amended are patentable in light of US 181, US 048 and US 626, considered either alone or in combination.

### **CONCLUSION**

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 1, 2, 5 through 17 and 19 through 21 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

It is not believed that extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time and/or fees are necessary to allow consideration of

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this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required is hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office to (571) 273-8300 on March 20, 2006.

*Claire Wygand*  
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